

JUN 15 2006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/511,792 Confirmation No.: 6292
Applicant(s): Radenne et al.
Filed: 5/9/2005
Art Unit: 2815
Examiner: Chu, Chris C.
Title: Method For Encapsulation Of A Chipcard And Module
Obtained Thus

Attorney Docket No.: 003D.0032.U1 (US)
Customer No.: 29,683

Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Petition To Commission(37 C.F.R. §1.181)

Sir:

This is a petition under 37 C.F.R. §1.181 to invoke the supervisory authority of the Commissioner.

Statement Of Facts

1. In an office action mailed 12/13/2005 the examiner issued a two-way restriction citing 35 U.S.C. §§ 121 and 372. The two Groups of claims were specified as follows:

I. Claims 1-4

II. Claims 5-13

2. In a Response filed on 01/09/2006 Applicants' Attorney elected Group I (Claims 1-4), but with traverse.

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3. In an office action mailed 02/27/2006, the examiner continued his restriction and made the restriction FINAL.

Point To Be Reviewed

Is the restriction of the claims 1-15 into two different groups of claims proper?

Action Requested

The Assistant Commissioner For Patents is requested to reverse the restriction requirement regarding the restriction of the claims in Groups I and II and direct the examiner to examine claims 1-15.

Discussion

This application is a national stage application submitted under 35 U.S.C. §371 based upon an International (PCT) application. Unity of invention practice is applicable in national stage applications submitted under 35 U.S.C. §371. Accordingly, a restriction requirement under 35 U.S.C. §121 is improper.

There was no lack of unity of invention identified during the International Stage of the application. This is because there is unity of invention among claims 1-13. Stating that the invention of Groups I-II "do not relate to a single general inventive concept" (as the examiner has stated) is incorrect. This is evident by the absence of a unity of invention invitation during the International Stage of the application. Clearly, the examiner has made an error.

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The examiner also cited PCT Rule 13.1 as a basis for his restriction. However, during the International Phase of this application, there was no unity of invention restriction raised. The examiner during the International Phase believed that there was unity of invention between claims 1-4 and claims 5-13. The USPTO, by failing to abide by the International Phase examiner's determination appears to be violating the PCT treaty. The examiner in the International Phase examined all of the claims. Thus, there is no undue burden for the U.S. examiner to continue examination of all of the claims of the application. In addition, the examiner has not identified any different classifications for the two groups of claims which would justify restriction. In addition, with the amendment filed 1/9/2006, the rational for the restriction stated by the examiner in the restriction office action is no longer present. The claims listed in Groups I and II relate to a single general inventive concept; they contain the same or corresponding special technical features. The examiner's rational for restriction is not valid.

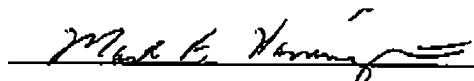
Summary

A requirement for two separate patents does not appear to be appropriate in view of the subject matter of the claims in groups I-II. The claims of Groups I-II (Claims 1-15) all appear to define the same essential features as specified in MPEP §806.03. The examiner has not shown that the provisions of MPEP 806.05(a)-(i) appear to apply to the claims of Groups I-III. Even if the provisions of MPEP 806.05(a)-(i) were shown to apply to the claims of Groups I-VI, because of MPEP

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\$806.03 restriction still would not be proper in this case. Therefore, the Assistant Commissioner For Patents is requested to reverse the examiner's restriction regarding the claims of Groups I-I, and direct the examiner to examine all the claims in these groups (i.e., claims 1-15).

Respectfully submitted,


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6/14/06
Date

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CERTIFICATION OF FACSIMILE TRANSMISSION

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